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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,691	10/14/2004	David Hands	20974YP	9304
210 7590 08/11/2008 MERCK AND CO., INC P O BOX 2000 RAHWAY, NJ 07065-0907			EXAMINER LOEWE, SUN JAE Y	
			ART UNIT 1626	PAPER NUMBER
			MAIL DATE 08/11/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/511,691	Applicant(s) HANDS ET AL.
Examiner SUN JAE Y. LOEWE	Art Unit 1626

—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 10 July 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 10 July 2008. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Kamal A Saeed, Ph.D./
Primary Examiner, Art Unit 1626

Continuation of 11, does NOT place the application in condition for allowance because: The instant claims are prima facie obvious over the entirety of the disclosure contained within US 5,719,147. Applicant's remarks are not persuasive in overcoming the previously made 35 USC 103 rejection.

First, Applicants argue that the present invention provides unexpected results relative to US 5,719,147. However, the instant invention results in 85% yield which is not considered to be statistically significant relative to the prior art yield of 79%. For this reason, the argument of unexpected results is not considered to be persuasive.

Second, notwithstanding the argument above, Applicants submit that the reconstruction of the instant claims based on the disclosure of US 5,719,147 is impermissible hindsight as it would not have provided motivation/guidance to perform the instant process. The argument has been considered, however, it is not found to be persuasive. As stated in the previous office action(s) of record (eg. pg. 3 of action dated April 11, 2008 & pg. 2 of office action dated October 15, 2007), the disclosure of US 5,719,147 as a whole provides teaching and direction to practice the claimed process. Schemes 5 and 6 teach the alkylation of the morpholinyl nitrogen to produce product (ie. relevant to reaction of instant formula 2 with formula 3). Hundreds of embodiments (for instance #17, 18, 30, 31, 33, 34, 44, 45, ... 75, 80, etc) and generic teaching (eg. column 24 1st paragraph) suggest further cyclization of the product from Schemes 5 and 6 to form 5-oxo-1,2,4-triazolo substituted compound (ie. relevant to instant cyclization of 4 to produce 1). The totality of the embodiments teach the limitations referenced by Applicant on pg. 9 of the response dated July 10, 2008. For example, Example 17 (column 75) teaches use of DMF, anhydrous potassium carbonate. Example 45 (column 88) teaches drying and further heating at 140-150 (by refluxing in xylenes). Furthermore, limitations that are not expressly taught are within the level of ordinary skill (ie. using a different starting material, example salt, to perform a known process).

In view of the discussion above, and the guidelines of MPEP 2143.E, the 35 USC 103 rejection is still deemed to be proper. Applicant's remarks are not persuasive in overcoming the rejection, and do not simplify issues for appeal. The response will therefore not be entered.